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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,029	09/24/2003	Takayuki Suzuki	17053	4550
23389 7590 09/03/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
NGUYEN, TUAN VAN				
ART UNIT		PAPER NUMBER		
3731				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/670,029

Applicant(s)

SUZUKI, TAKAYUKI

Examiner

TUAN V. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) 2-5, 8, 9 and 11-15 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 6, 7, 10 and 16-23 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. In previous Office Action, claims 1-21 are pending; claims 1, 6, 7, 10, and 16-21 were examined and rejected.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 9, 2008 has been entered.

Response to Amendment

3. According to the Amendment filed on July 9, 2008, claims 22 and 23 are new. Accordingly, claims 1-23 are pending in this present application and claims 1, 6, 7, 10 and 16-23 are presented for examination.
4. According to the Amendment filed on July 9, 2008, claim 21 has been amended to overcome the rejection under 35 USC § 112, second paragraph, therefore, the rejection in previous Office action is hereby withdrawn.
5. Applicant's arguments filed on July 9, 2008 with respect to the rejection of claims under 35 USC § 102 and 103 have been fully considered but they are not

persuasive. Applicant argues that link rod 104a connects the link 105a with the forceps and therefore can be said together correspond to a junction of the claimed invention, therefore, the link rod 104a and the link 105a are not situated on the reference plane that is substantially containing the longitudinal axis of the tubular sheath and extending parallel to the second rocking axis, when the operating section is closed, therefore, the link rod 105a and the link pin 103a correspond to parts of the manipulators, not to the junctions is incorrect. Figure 16 of Suzuki's drawings (JP02000279418A) discloses a pair of junctions 105a, 105b connected to forceps at pins 104a, 104b, respectively, and the pair of junctions connected to the manipulators at pins 103a, 103b, respectively to rock the forceps around the second axis, which is located at pins 103a and 103b. Figure 16 of Suzuki also discloses the second axis which located at pins 103a and 103b are situated substantially on a reference plane containing the longitudinal axis of the tubular sheath and extending parallel to the second rocking axis. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims see *In re Van Genuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Noting that nowhere in the claims does the applicant further define the structure of the pair of junctions, thus, the claims in a pending application should be given their broadest reasonable interpretation.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 1, 6, 7, 16, 20 and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Suzuki (JP02000279418A).**
8. Referring to claim 1, Suzuki discloses (see Figs. 15-16 and 2, 3, 4, and 5a-5d) an medical instrument comprising: a swingable operating section 12a, 12b formed of a pair of forceps which rock around a first rocking axis defined by pins 22a, 22b ; a tubular sheath 4 having a distal end portion situated on a proximal end side of the operating section, the distal end portion having a circular-section portion having a circular cross section perpendicular to a longitudinal central axis thereof and a pair of symmetrical flat portions 15a, 15b formed by cutting the opposite sides of the circular-section portion and in sliding contact with respective proximal end portions of the forceps; a pair of wire or manipulator 101 which advances and retreats in the longitudinal direction of the sheath, thereby rocking the forceps around the first rocking axis; and a pair of junctions 105a and 105b, which connected the manipulator for rocking motion around a second rocking axis, which defined by pins 103a, 103b, the junctions being situated substantially on a reference plane passing through the longitudinal central axis of the sheath and extending parallel to the second rocking axis when the operating section is closed and open.

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9. Referring to **claims 6 and 7**, Suzuki (see Figs. 15-16) pins 22a, 22b, defined the first rocking axis, includes a shank and wherein the shank having a spread portion (juxtapose to the oval tube 9) formed on one of the ends of the pin that having a larger in outer diameter than the shank portion.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Lucey et al. (US 5,782,834).**

13. Suzuki discloses the invention substantially as claimed except for the first rocking axis of each forceps is not on the reference plane when the operating section is closed. However, Lucey et al. disclose the distal portion of a forceps that has the

ability to articulate in order to gain the advantage of allowing the user to rotate the surgical tool, rather than the entire surgical instrument, to change the angle of attack of the surgical tool, despite the curvature imposed by the bend region and because the surgical tool can be rotated to any desired angular position, the invention allows a single surgical instrument to be used to grasp or cut tissue at any angular orientation with respect to the axis of the instrument, therefore, the design eliminates the need for a set of curved instruments having surgical tools located at different fixed angular positions (e.g., directed up, down, to the left, and to the right with respect to the axis of the instrument) (Summary of Invention). It would have been obvious to one of ordinary skill in the art to incorporate the design intended of having the distal portion of the forceps that has the ability to articulate as disclosed by Lucey et al. into the device Suzuki so that it too would have the same advantage. In the event that the distal portion of the modified device of Suzuki is bent then the first rocking axis of each forceps is not on the reference plane, which contains the longitudinal axis of the sheath.

14. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki.**
15. Suzuki discloses the invention substantially as claimed except for specifically discloses the wires are made from stainless spring steel and superelastic alloy. Examiner takes an official notice that the actuating wire or actuating rod in an endoscopic forceps are made from stainless spring steel and superelastic alloy is old and well known in the art. Extrinsic evidence, US Patent No. 6,689,122 issued

to Yamamoto (see col. 6, lines 35-40). Nowhere in the applicant arguments/remark in an amendment filed on July 9, 2008 indicates that applicant traverses the examiner's assertion of official notice. Therefore, the statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice.

16. **Claims 10 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Townsend et al (US 6,066,102).**
17. Referring to **claims 10 and 21-23**, examiner understood that applicant intended to claim a pair of junctions which are the pins 23a as shown in Fig. 2B of this instant application and considered as such for the examination purposes. The device of Suzuki discloses the invention substantially as claimed except for specifically discloses that the pins that securing the forceps to the distal end portion of the tubular sheath are not to project into the bore of the distal end portion. However, Townsend discloses such a feature. Townsend discloses (see Figs. 4a-4b) housing 60 connected to tubular member, wherein the tubular member includes access lumen 28 provides access for optical fiber 900 or fluid (see col. 6, lines 37-50) and the housing 60 further includes cam pins 68 are integral with the flats 66 of the housing (see col. 6, line 57 to col. 7, line 7). Figure 4b of Townsend's drawings clearly shown that the pins are not enter into the bore of the housing 60, apparently for the purpose of eliminating interference between the pins and optical fiber or improving of the flow of fluid. Therefore, it would have been obvious to one

- of ordinary skill in the art to incorporate the design of the pins as disclosed by Townsend into the device of Suzuki so that it too would have the same advantage.
18. **Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Suzuki (US 6,110,127).**
19. The device of Suzuki (JP02000279418A) discloses the invention substantially as claimed except for the distal end portion of the tubular sheath is outwardly open. However, Suzuki (US 6,110,127) discloses such a feature. Suzuki discloses (see Figs. 16A and 17-19) an endoscopic device comprising, among other things, a distal unit 15 has a storage tube 22, wherein the storage tube provide a storage space 22a. Apparently that the storage space is outwardly open for the purpose of storing tissue samples. Therefore, it would have been obvious to one of ordinary skill in the art to incorporate this design into the distal end of Suzuki device (JP02000279418A) so that it too would have the same advantage.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./

Examiner, Art Unit 3731

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3731